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OFFICE OF PETITIONS

In re Application of :
Soong et al. :
Application No.: 10/065988 : ON PETITION
Filing or 371(c) Date: 12/06/2002 :
Attorney Docket Number: P003 :

This is a decision on the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b), filed November 6, 2006.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely reply to the non-final office action, mailed April 19, 2005. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on July 10, 2005. A Notice of Abandonment was mailed April 20, 2006.

Applicant filed petitions to withdraw the holding of abandonment on April 23, 2006; June 30, 2006 and August 17, 2006, which were dismissed in Decisions mailed June 23, 2006 and September 20, 2006, for failing to meet the requirements of a grantable petition under 37 CFR 1.181.

Applicant files the instant petition to revive the application. No reply to the April 19, 2005 Office action has been filed.

Moreover, in an Interview Summary mailed April 7, 2006, the Examiner noted that Mr. Soong "agreed to abandon this case for now...."

Applicable Law, Rules and MPEP

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

However, an applicant is unable to make the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional, where there is shown to be intentional delay.

The MPEP provides

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an “unintentional” delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render “unintentional” the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

D. Delay Until the Filing of a Grantable Petition

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

- (A) the delay in reply that originally resulted in the abandonment;

- (B) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and
- (C) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See Application of G, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

- (A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;
- (B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or
- (C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an “unavoidable” or “unintentional” delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldague*, 10 USPQ2d at 1478.

MPEP 711.03(c)(2)

Analysis and conclusion

Applicant made a deliberate decision to permit this application to be abandoned when he “agreed to abandon this case for now”. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

Further correspondence with respect to this matter should be addressed as follows:

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By FAX: (571) 273-8300
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Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.



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